

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*In re* the Application of:

**Dan Kikinis**

Serial No.: 09/875,460

Filed: June 5, 2001

For: Remote Control of Program  
Scheduling

Atty. Docket No.: 007287.00036

Group Art Unit: 2421

Examiner: Salce, Jason P.

Confirmation No.: 6281

**APPEAL BRIEF**

**Mail Stop: Appeal**

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Sir:

This is an Appeal Brief filed in support of Appellant's November 16, 2009, Notice of Appeal and is filed in response to the Notice of Panel Decision from Pre-Appeal Brief Review, dated January 13, 2010. Appeal is taken from the Final Office Action mailed July 16, 2009 ("Final Office Action").

Appellant requests any necessary extension of time for the submission of this paper. If any fees are required, please charge Deposit Account No. 19-0733 accordingly.

**REAL PARTY IN INTEREST**

37 C.F.R. § 41.37(c)(1)(i)

The owner of this application, and the real party in interest, is JLB Ventures, LLC.

**RELATED APPEALS AND INTERFERENCES**

37 C.F.R. § 41.37(c)(1)(ii)

There are no related appeals or interferences.

**STATUS OF CLAIMS**

37 C.F.R. § 41.37(c)(1)(iii)

Claims 1-3, 6-11, 14-16 and 27-30 stand rejected and are presently appealed. Claims 4, 5, 12, 13, and 17-26 were previously canceled.

**STATUS OF AMENDMENTS**

37 C.F.R. § 41.37(c)(1)(iv)

No amendments have been made subsequent to final rejection.

**SUMMARY OF CLAIMED SUBJECT MATTER**

37 C.F.R. § 41.37(c)(1)(v)

In making reference herein to various embodiments in the specification text and/or drawings to explain the claimed invention, Appellants do not intend to limit the claims to those embodiments; all references to the specification and drawings are illustrative unless otherwise explicitly stated. Applicants' Response dated May 1, 2009, amended the specification to include material previously incorporated by reference from patent application 09/488,361, which is now U.S. Patent No. 6,421,067. Applicants refer to the specification, as amended, ("Specification"), for the cited support.

### **Independent Claim 1**

Independent claim 1 is directed to a method for simultaneously interacting with an electronic program guide (EPG) using multiple devices. *See e.g.*, paragraphs [0014], ll. 1-4, [0017], ll. 7-10; Fig. 2; Fig. 3. The method includes transmitting the EPG over the Internet to a web-enabled cellular phone having a first video display, wherein the EPG includes preset selections. *See e.g.*, paragraphs [0036], ll. 1-5, [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 2; Fig. 3. The method further includes displaying the EPG on the first video display of the web-enabled cellular phone. *See e.g.*, paragraphs [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 3. The method further includes indicating which buttons on the web-enabled cellular phone are appropriate for performing functions for the EPG. *See e.g.*, paragraphs [0035], ll. 1-5, [0036], ll. 1-5, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 2; Fig. 3. The method further includes receiving selections entered over the Internet via the web-enabled cellular phone. *See e.g.*, paragraphs [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 3. The method further includes storing the EPG selections on a storage device. *See e.g.*, paragraphs [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 3. The method further includes transmitting the EPG selections to be displayed on a second video display associated with a television when requested. *See e.g.*, paragraphs [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 3.

### **Independent Claim 9**

Independent claim 9 is directed to a machine readable medium having stored thereon a set of instructions, which when executed cause a system to perform a method for simultaneously interacting with an electronic program guide (EPG). *See e.g.*, paragraphs [0014], ll. 1-4, [0017], ll. 7-10; Fig. 2; Fig. 3; *see also* paragraph [0043], ll. 1-9. The method includes transmitting the EPG over the Internet to a web-enabled cellular phone having a first video display, the EPG including

present selections. *See e.g.*, paragraphs [0036], ll. 1-5, [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 2; Fig. 3. The method further includes displaying the EPG on the first video display of the web-enabled cellular phone. *See e.g.*, paragraphs [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 3. The method further includes indicating which buttons on the web-enabled cellular phone buttons are appropriate for performing functions for the EPG. *See e.g.*, paragraphs [0035], ll.1-5, [0036], ll. 1-5, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 2; Fig. 3. The method further includes receiving selections entered over the Internet via the web-enabled cellular phone. *See e.g.*, paragraphs [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 3. The method further includes storing the EPG selections on a storage device. *See e.g.*, paragraphs [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 3. The method further includes transmitting the EPG selections to be displayed on a second video display associated with the television when requested. *See e.g.*, paragraphs [0038], ll. 1-8, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 3.

#### **Dependent Claim 27**

Dependent claim 27 depends from claim 1, and further recites “wherein indicating which buttons on the web-enabled cellular phone are appropriate includes illuminating LEDs corresponding to the appropriate buttons.” *See e.g.*, paragraphs [0030], ll. 6-18, [0035], ll. 1-5, [0036], ll. 1-5, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 2; Fig. 3.

#### **Dependent Claim 29**

Dependent claim 29 depends from claim 9, and further recites “wherein indicating which buttons on the web-enabled cellular phone are appropriate includes illuminating LEDs corresponding to

the appropriate buttons.” *See e.g.*, paragraphs [0030], ll. 6-18, [0035], ll. 1-5, [0036], ll. 1-5, [0039], ll. 1-7, [0040], ll. 1-6; Fig. 2; Fig. 3.

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

37 C.F.R. § 41.37(c)(1)(vi)

Claims 1-3, 6-11, 14-16 and 27-30 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Claims 1-3, 6, 9-11, 14, 28 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208, “Ellis Publication”) in view of Ellis et al. (U.S. Patent No. 6,774,926, “Ellis Patent”) in further view of Yoshida (U.S. Patent No. 5,936,611, “Yoshida”).

Claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ellis Publication in view of the Ellis Patent in further view of Yoshida and in further view of Cooper et al. (U.S. Patent No. 6,754,904, “Cooper”).

Claims 8 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ellis Publication in view of the Ellis Patent in further view of Yoshida and in further view of Terakado et al. (U.S. Patent No. 6,246,441, “Terakado”).

Claims 27 and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis Publication in view of Ellis Patent in further view of Yoshida in further view of Dustin (U.S. Patent No. 6,853,308, “Dustin”).

### **ARGUMENT**

37 C.F.R. § 41.37(c)(1)(vii)

#### ***I. Rejection under U.S.C. § 112, First Paragraph***

With respect to independent claims 1 and 9, the Final Office Action rejects independent claims 1 and 9 at page 3 for failing to find support in the specification for the feature, “wherein the EPG includes an indication of which web-enabled cellular phone buttons are appropriate for the EPG.” Appellant respectfully disagrees.

The standard of determining compliance with the written description requirement is assessed based on whether a person skilled in the art would recognize in an applicant’s disclosure a description of the invention defined by the claims. MPEP § 2163.04 (citing *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976)).

Appellant’s Response dated May 1, 2009, amended the specification to include material previously incorporated by reference from patent application 09/488,361, which is now U.S. Patent No. 6,421,067 (“the ‘067 Patent”). The Final Office Action correctly notes at page 3 that the ‘067 Patent discloses an EPG that indicates which buttons on a remote control device are appropriate for performing functions for the EPG. The Final Office Action takes the position at pages 3-4 that the ‘067 Patent fails to teach that a web-enabled cellular phone is used as a remote control device and that it also fails to teach that the remote control unit contains a display screen for displaying an EPG. Support, however, can be found throughout the specification, as amended in Applicants’ Response dated May 1, 2009 (“Specification”). For example, the Specification provides support for a web-enabled cellular phone having the functions of a remote control device. Particularly, the Specification at paragraph [0036], ll. 1-5, provides that “[a] wireless hand held device, such as hand held unit 220 [of Fig. 2] allows for a great deal of flexibility. A user may move about the room which contains video display 105 [of Fig. 2] and be able to control the functions of the EPG from any point. When using a wireless hand held device to control the EPG, the device may also assume the functions of the remote control device.”

(Emphasis added.) Further, the Specification at paragraph [0035], line 3, provides that “[h]and held unit 220 [of Fig. 2], could, for example, be a personal digital assistant (PDA).” Thus, based on these sections and the instant specification as a whole, one of skill in the art would readily appreciate that a web-enabled cellular phone is used as a remote control device. In addition, one skilled in the art will appreciate that hand held unit 220 of Fig. 2 could be web-enabled phone and that such devices can contain a display screen large enough to allow for an EPG to be displayed therein. *See also Id.* at paras. [0039], ll. 1-7, [0040], ll. 1-6. Based on these sections and the instant specification as a whole, one of skill in the art would readily appreciate that a web-enabled cellular phone is used as a remote control device and “the EPG includes an indication of which web-enabled cellular phone buttons are appropriate for the EPG,” as recited by independent claims 1 and 9.

Therefore, for at least these reasons, Appellant has satisfied the written description requirement for the claimed subject matter and thus respectfully requests that the rejections of claims 1-3, 6-11, 14-16 and 27-30 under 35 U.S.C. 112, first paragraph, be withdrawn.

## ***II. Rejections under U.S.C. §103(a).***

### ***A. Independent Claims 1 and 9***

Claim 1 recites “displaying the EPG on the first video display of the web-enabled cellular phone and indicating which buttons on the web-enabled cellular phone are appropriate for performing functions for the EPG.” The Final Office Action correctly notes at p. 6 that neither Ellis Publication nor Ellis Patent teaches or suggests, either separately or in combination, indicating which buttons on the web-enabled cellular phone buttons are appropriate for performing functions for the EPG. Instead, the Office relies on Yoshida as describing this function. Final Office Action, page 6. Specifically, the Final Office Action states at page 6 that “Yoshida

discloses an EPG that displays an image of the remote control the viewer is using” and Yoshida “discloses displaying a help screen that indicates which buttons a remote control device that are appropriate for performing functions for the EPG.”

While Yoshida describes providing information about the function of a user identified key, Yoshida fails to teach or suggest indicating which buttons are appropriate for performing functions for the EPG. Yoshida describes a user help function that provides a functional description of what a remote control key does. *See* Yoshida, col. 6, line 30 – col. 8, line 29. This is reinforced in Figs. 7 and 8, where Yoshida describes providing information on the function of a specific key, as requested by a user. Yoshida, Fig. 7; Fig. 8. That is, in Yoshida, a user first identifies the key and subsequently receives functionality information about the key. *See* Yoshida, col. 6, line 30 – col. 8, line 29. In contrast, claim 1 recites “indicating which buttons on the web-enabled cellular phone are appropriate for performing functions for the EPG” (emphasis added). Providing such an indication is a novel and non-obvious distinction over the cited combination of documents, because Yoshida merely describes providing the functional description of a particular key chosen by a user.

Since none of Yoshida, Ellis Publication, and Ellis Patent, either alone or in any combination, teaches or suggests “indicating which buttons on the web-enabled cellular phone are appropriate for performing functions for the EPG” as recited by claim 1, claim 1 is patentably distinguishable over the cited combination of documents. Accordingly, claim 1 is in condition for allowance.

Independent claim 9 also recites “indicating which buttons on the web-enabled cellular phone are appropriate for performing functions for the EPG.” Therefore, for at least the reasons similar to



those discussed above with respect to claim 1, claim 9 is also patentably distinguishable over the cited combination of Yoshida, Ellis Publication, and Ellis Patent and is allowable.

***B. Dependent Claims 27 and 29***

Claims 27 and 29 recite, “wherein indicating which buttons on the web-enabled cellular phone are appropriate includes illuminating LEDs corresponding to the appropriate buttons.” The Final Office Action, on page 7, alleges that Dustin discloses these features at col. 4, lines 6-8 (“The top row of buttons 2 includes a power button and a ‘Light’ button that illuminates the buttons so that the device can be used in a darkened room”). Appellant respectfully disagrees. Although the cited portion refers to illuminating buttons on a device, Appellant notes that a button for illuminating a keypad does not describe illuminating a button to indicate which buttons on the web-enabled cellular phone are appropriate. Indeed, Dustin does not teach or suggest “wherein indicating which buttons on the web-enabled cellular phone are appropriate includes illuminating LEDs corresponding to the appropriate buttons,” as recited in claims 27 and 29. Thus, claims 27 and 29 are patentably distinguishable over the asserted combination of Yoshida, Ellis Publication, Ellis Patent and Dustin, and are allowable for at least these reasons.

***C. Dependent Claims 2, 3 6-8, 10, 11, 14-16, 28 and 30***

Claims 2, 3, 6, 10, 11, 14, 28 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Ellis Publication in view of the Ellis Patent in further view of Yoshida. Claims 2, 3, 6, 10, 11, 14, 28 and 30 are dependent on claims 1 and 9, respectively, and are thus allowable for at least the same reasons as their respective base claim.

Claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ellis Publication in view of the Ellis Patent in further view of Yoshida and in further view of Cooper. Claims 7 and 15 are dependent on claims 1 and 9, respectively. Cooper fails to cure the

noted deficiency discussed above with respect to claims 1 and 9, and is cited for other features (Final Office Action, page 8). Therefore, claims 7 and 15 are allowable for at least these reasons.

Claims 8 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ellis Publication in view of the Ellis Patent in further view of Yoshida and in further view of Terakado. Claims 8 and 16 are dependent on claims 1 and 9, respectively. Terakado fails to cure the noted deficiency discussed above with respect to claims 1 and 9, and is cited for other features (Final Office Action, page 9). Therefore claims 8 and 16 are allowable for at least these reasons.

**CONCLUSION**

For all of the foregoing reasons, Appellant respectfully submits that the rejections of claims 1-3, 6-11, 14-16 and 27-30 in the Final Office Action are improper and should be reversed.

Respectfully submitted,  
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Dated: February 12, 2010

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**CLAIMS APPENDIX**

37 C.F.R. § 41.37(c)(1)(viii)

Claims involved in the appeal:

1. A method for simultaneously interacting with an electronic program guide (EPG) using multiple devices comprising:

transmitting the EPG over the Internet to a web-enabled cellular phone having a first video display, wherein the EPG includes preset selections;

displaying the EPG on the first video display of the web-enabled cellular phone and indicating which buttons on the web-enabled cellular phone are appropriate for performing functions for the EPG;

receiving selections entered over the Internet via the web-enabled cellular phone;

storing the EPG selections on a storage device; and

transmitting the EPG selections to be displayed on a second video display associated with a television when requested.

2. The method for simultaneously interacting with an electronic program guide using multiple devices of claim 1, wherein the EPG selections are stored on a broadcast server.

3. The method for simultaneously interacting with an electronic program guide using multiple devices of claim 1, wherein the EPG selections are stored on a set top box (STB).

6. The method for simultaneously interacting with an electronic program guide using multiple web-enabled cellular phones of claim 1, further including transmitting the EPG selections over the Internet to web-enabled cellular phones when requested.

7. The method for simultaneously interacting with an electronic program guide using multiple web-enabled cellular phones of claim 6, further including transmitting the EPG selections over the

Internet to multiple web-enabled cellular phones to be displayed concurrently when requested.

8. The method for simultaneously interacting with an electronic program guide using multiple web-enabled cellular phones of claim 6, further including transmitting one or more programs to be separately displayed concurrently with displaying the EPG selections.

9. A machine readable medium having stored thereon a set of instructions, which when executed cause a system to perform a method for simultaneously interacting with an electronic program guide (EPG) comprising:

- transmitting the EPG over the Internet to a web-enabled cellular phone having a first video display, the EPG including present selections;

- displaying the EPG on the first video display of the web-enabled cellular phone and indicating which buttons on the web-enabled cellular phone buttons are appropriate for performing functions for the EPG;

- receiving selections entered over the Internet via the web-enabled cellular phone;

- storing the EPG selections on a storage device; and

- transmitting the EPG selections to be displayed on a second video display associated with the television when requested.

10. The machine readable medium of claim 9, wherein the EPG selections are stored on a broadcast server.

11. The machine readable medium of claim 9, wherein the EPG selections are stored on a set top box (STB).

14. The machine readable medium of claim 9, further including transmitting the EPG selections over the Internet to the web-enabled cellular phone to be displayed when requested.

15. The machine readable medium of claim 14, further including transmitting the EPG selections over the Internet to multiple web-enabled cellular phones to be displayed concurrently when requested.

16. The machine readable medium of claim 14, further including transmitting one or more programs to be separately displayed concurrently with displaying the EPG selections.

27. The method for simultaneously interacting with an electronic program guide of claim 1, wherein indicating which buttons on the web-enabled cellular phone are appropriate includes illuminating LEDs corresponding to the appropriate buttons.

28. The method for simultaneously interacting with an electronic program guide of claim 1, wherein indicating which buttons on the web-enabled cellular phone are appropriate includes displaying an indication in the EPG for which buttons are appropriate.

29. The machine readable medium of claim 9, wherein the EPG, wherein indicating which buttons on the web-enabled cellular phone are appropriate includes illuminating LEDs corresponding to the appropriate buttons.

30. The machine readable medium of claim 9, wherein the EPG, wherein indicating which buttons on the web-enabled cellular phone are appropriate includes displaying an indication in the EPG for which buttons are appropriate.

**EVIDENCE APPENDIX**

37 C.F.R. § 41.37(c)(1)(ix)

None.

**RELATED PROCEEDINGS APPENDIX**

37 C.F.R. § 41.37(c)(1)(x)

None.